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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,454	08/24/2001	Carol J. Collins	NEU-40	2232

27777 7590 08/29/2003
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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/29/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/938,454

Applicant(s)

COLLINS ET AL.

Examiner

Humera N. Sheikh

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

Receipt of the request for extension of time (1 month) and the Request for Reconsideration, both filed 08/11/03 is acknowledged.

The examiner also acknowledges the applicants' intent to submit an English translation of EPO No. 1,066,814.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claims 1-24 are pending. Claims 1-24 are rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1615

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shukuzaki *et al.* (US Pat. No. 5, 266,321) in view of Sunkel *et al.* (US Pat. No. 6,542,598 B2).

Shukuzaki teach an oily make-up cosmetic comprising a silicone gel composition, which comprises a partially crosslinked organopolysiloxane polymeric compound and a low viscosity silicone oil (see reference column 2); (col.7); (col.8, lines 47-56); and examples. Specific examples of the low viscosity oils are: dimethylpolysiloxane, methylphenylpolysiloxane, octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane and the like (col. 7, lines 3-16). Various cosmetic powders, such as mica can be included in the composition (col. 7, lines 32-45). The make-up cosmetic can be applied to a foundation, eye shadow, face powder, lip stick and the like and can take various forms including a solid, stick and the like (col. 8, lines 53-56).

Shukuzaki is deficient only in the sense that he does not explicitly teach the make-up cosmetic in the form of mascara.

Sunkel teaches cosmetic compositions comprising siloxane elastomers wherein the composition may be in the form of a foundation, *mascara*, eye shadows, powders, blushers, lip color and the like (see reference column 2, lines 35-55); Example II and claims 1, 13 and 20.

Art Unit: 1615

Therefore, it would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to use the teachings of Sunkel within the teachings of Shukuzaki because Sunkel explicitly teaches cosmetic compositions comprising organopolysiloxane elastomers wherein the cosmetic composition may be in various forms, such as foundation, *mascara*, eye shadows, powders, lip color, blushers and the like and similarly, Shukuzaki teaches the use of polyorganosiloxane elastomers in a make-up cosmetic wherein the composition can be applied to foundations, eye shadows, face powder, lip stick and the like and can take various forms including a solid, stick. The expected result would be an improved, cosmetic composition, such as in the form of mascara, that provides softening, moisturizing and conditioning properties.

Prior Art made of record and deemed relevant by the Examiner:

US Pat. No. 5, 412,004 Tachibana *et al.* 02/1994

Response to Arguments

The applicant's arguments filed 08/11/03 have been fully considered, but were not found to be persuasive.

Firstly, the applicant argued, "Shukuzaki is silent with respect to mascara, which is applied to the eyelashes and eyebrows, and that, Shukuzaki relates to cosmetics that

Art Unit: 1615

are applied to the skin and that the compositions of Shukuzaki actually teaches away from mascaras, which require stickiness in order to help the compositions adhere to the hairs."

These arguments have been fully considered, but were not found to be persuasive. Shukuzaki teaches an oily make-up cosmetic comprising a silicone gel composition, which comprises a partially crosslinked organopolysiloxane polymeric compound and a low viscosity silicone oil (see column 2); (col.7); (col.8, lines 47-56); and examples. The make-up cosmetic can be applied to a foundation, eye shadow, face powder, lip stick and the like and can take various forms including a solid, stick and the like (col. 8, lines 53-56). Although Shukuzaki does teach that the composition can be applied in various forms (i.e., foundation, eye shadow, powders), Shukuzaki is lacking only in the sense that he does not explicitly teach the composition in the form of mascara. Sunkel resolves this only deficiency of Shukuzaki and was relied upon for the generic teaching of polysiloxane elastomers in a mascara formulation. Sunkel also teaches that the cosmetic composition may be in the form of foundations, eye shadows, powders, lip colors and the like and can provide improved skin-feel properties (see col. 1, line 59 through col. 2, line 55).

Secondly, the applicant argued, "While Sunkel et al. does disclose the use of silicone elastomers in mascara, Sunkel et al. does not disclose, nor suggest, a mascara that comprises less than about 1%, by weight of wax, as set forth in independent claim 1 of the present application. The mascara of Sunkel comprises 3% carnauba wax, 3.75% white beeswax, 2.25% paraffin wax 118/125, and 2.25% paraffin wax."

The applicants arguments have been fully considered, but were not found to be persuasive. The teachings of Sunkel have been delineated above. Sunkel teaches the use of siloxane elastomers in mascara formulations (see col. 2, lines 35-55, example II and claims). The applicants argument that Sunkel does not teach less than about 1% by weight of wax is not persuasive, since, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The use of wax in amounts greater than about 1% would not be considered detrimental to the formulation itself since Sunkel explicitly teaches a mascara formulation which provides benefits of improved feel, such as softening, moisturization and conditioning. Furthermore, one of ordinary skill in the art would be able to determine suitable amounts of wax through routine or manipulative experimentation to obtain the best possible results. In addition, the applicants have not shown any criticality that accrues from the use of less than about 1% by weight of wax. The mascara of Sunkel utilizes similar ingredients for a similar intended purpose as the applicants. Hence, the instant invention is rendered obvious and unpatentable over the prior art.

Art Unit: 1615

Correspondence

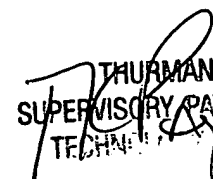
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (703) 308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

hns

August 28, 2003

 THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 1600